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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/709,254	04/23/2004	James M. Murphy	PU2212	3253

23454 7590 03/10/2006

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EXAMINER	
PASSANITI, SEBASTIANO	
ART UNIT	**PAPER NUMBER**
3711	

DATE MAILED: 03/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/709,254	MURPHY ET AL.	
	Examiner	Art Unit	
	Sebastiano Passaniti	3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *see detailed Office action*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-64* is/are pending in the application.

4a) Of the above claim(s) *31-40 and 62-64* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-30 and 41-61* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *04/23/2004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☒ Other: *Sample TD and §3.73*.

DETAILED ACTION

This Office action is responsive to communication received 12/27/2005 – Election.

Claims 1-64 remain pending.

Applicant's election without traverse of Species I (claims 1-30 and 41-61) in the reply filed on 12/27/2005 is acknowledged.

Claims 31-40 and 62-64 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 12/27/2005.

Following is an action on the MERITS:

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.

1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-30 and 41-60 are rejected under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 1-15 of U.S. Patent No. 6,491,592. For double patenting to exist as between the rejected claims and the patented claims 1-15, it must be determined that the rejected claims are not patentably distinct from claims 1-15 of the patent. In order to make this determination, it first must be determined whether there are any differences between the rejected claims and patented claims 1-15 and, if so, whether those differences render the claims patentably distinct.

By way of example only, instant claim 11 (dependent from claim 1) recites that "the aft-body is composed of a plurality of plies of pre-peg material" in combination with

a face component of metal material, a return portion and a coefficient of restitution of 0.81 and 0.94.

It is clear that all the elements of claim 11 are to be found in the patented claims. The difference between instant claim 11 and claims 1-15 of the patent lies in the fact that the patent claims include many more elements and are thus much more specific. Thus the invention of claims 1-15 of the patent is in effect a "species" of the "generic" invention of claim 11. It has been held that the generic invention is "anticipated" by the "species". See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since claim 11 is anticipated by claims 1-15 of the patent, it is not patentably distinct from claims 1-15 of the patent.

The remaining limitations of the instant application may be found in the '592 patent and, as an example only, note the following:

As to instant claim 2, see claim 2 of the '592 patent.

As to instant claim 3, see claim 3 of the '592 patent.

As to instant claim 4, see claim 4 of the '592 patent.

As to instant claim 5, see claim 5 of the '592 patent.

As to instant claim 6, see claim 6 of the '592 patent.

As to instant claim 7, see claim 7 of the '592 patent.

As to instant claim 8, see claim 8 of the '592 patent.

As to instant claim 9, see claim 10 of the '592 patent.

As to instant claim 52, see claim 14 of the '592 patent.

Claims 1-9, 11, 20, 22, 30, 41, 43, 45, 46, 51, 52, 54 and 61 are rejected under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 1-13 of U.S. Patent No. 6,739,982. It is clear that all the elements of claims 1-9, 11, 20, 22, 30, 41, 43, 45, 46, 51, 52, 54 and 61 are to be found in the patented claims. The difference between instant claim and claims 1-13 of the patent lies in the fact that the patent claims include many more elements and are thus much more specific. Thus the invention of claims 1-13 of the patent is in effect a "species" of the "generic" invention of claims 1-9, 11, 20, 22, 30, 41, 43, 45, 46, 51, 52, 54 and 61. It has been held that the generic invention is "anticipated" by the "species". See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since the instant claims are anticipated by claims 1-13 of the patent, they are not patentably distinct from claims 1-13 of the patent.

Claims 1, 6 and 7 are rejected under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 1-7 of U.S. Patent No. 6,354,962. It is clear that all the elements of claims 1, 6 and 7 are to be found in the patented claims. The difference between instant claim and claims 1-7 of the patent lies in the fact that the patent claims include many more elements and are thus much more specific. Thus the invention of claims 1-7 of the patent is in effect a "species" of the "generic" invention of claims 1, 6 and 7. It has been held that the generic invention is "anticipated" by the "species". See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since the instant claims are anticipated by claims 1-7 of the patent, they are not patentably distinct from claims 1-7 of the patent.

Claims 1, 2, 3, 4, 6, 9, 20, 30, 52 and 61 are rejected under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 1-10 of U.S. Patent No. 6,758,763. It is clear that all the elements of claims 1, 2, 3, 4, 6, 9, 20, 30, 52 and 61 are to be found in the patented claims. The difference between instant claim and claims 1-10 of the patent lies in the fact that the patent claims include many more elements and are thus much more specific. Thus the invention of claims 1-10 of the patent is in effect a "species" of the "generic" invention of claims 1, 2, 3, 4, 6, 9, 20, 30, 52 and 61. It has been held that the generic invention is "anticipated" by the "species". See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since the instant claims are anticipated by claims 1-10 of the patent, they are not patentably distinct from claims 1-10 of the patent.

Claims 1-6, 9, 11, 13-18, 20, 22, 24-30, 41, 43, 45-52 and 56-61 are rejected under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 1-12 of U.S. Patent No. 6,994,637. It is clear that all the elements of claims 1-6, 9, 11, 13-18, 20, 22, 24-30, 41, 43, 45-52 and 56-61 are to be found in the patented claims. The difference between instant claim and claims 1-12 of the patent lies in the fact that the patent claims include many more elements and are thus much more specific. Thus the invention of claims 1-12 of the patent is in effect a "species" of the "generic" invention of claims 1-6, 9, 11, 13-18, 20, 22, 24-30, 41, 43, 45-52 and 56-61. It has been held that the generic invention is "anticipated" by the "species". See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since the instant

claims are anticipated by claims 1-12 of the patent, they are not patentably distinct from claims 1-12 of the patent.

Comments on Double Patenting

Applicant's attention is drawn to the listing of applications related to the instant application, shown in the continuity information (below). Applicant is respectfully reminded to maintain a clear line of demarcation among all of the claims of the instant application and any related application in order to avoid the need to address further instances with respect to obviousness-type double patenting between the instant claims and any one of the plethora of related applications (or patents matriculating therefrom) that may arise during the course of prosecution of the instant application.

09481167 **is a continuation in part of** 09431982
09548314 **is a continuation in part of** 09431982
09548531 **is a continuation in part of** 09431982
09548538 **is a continuation in part of** 09431982
09548968 **is a continuation in part of** 09431982
09606809 **is a continuation in part of** 09481167
09683118 **is a continuation of** 09431982
09683401 **is a division of** 09548538
09683402 **is a division of** 09548968
09683856 **is a continuation in part of** 09906889
09683860 **is a continuation in part of** 09906889
09683896 **is a continuation in part of** 09906889
09683906 **is a continuation of** 09431982
09705253 **is a continuation in part of** 09431982
09906889 **is a continuation in part of** 09431982
10063266 **is a continuation of** 09906889
10063393 **is a continuation in part of** 09906889
10063927 **is a continuation of** 09606809
10065871 **is a continuation in part of** 09906889
10248742 **is a continuation of** 10065871
10249054 **is a continuation of** 09683906
10249510 **is a continuation in part of** 09683860
10249782 **is a continuation in part of** 09683860
10250089 **is a continuation of** 09683856

10604370 **is a continuation of** 10249054
10605291 **is a continuation of** 10063927
10655142 **is a continuation of** 10249054
10709213 **is a continuation of** 10249510
10709247 **is a continuation of** 10065871
10709254 **is a continuation of** 10065871
10709618 **is a continuation of** 10247742
10709914 **is a continuation in part of** 10065871
10710352 **is a continuation in part of** 10065871
10906796 **is a continuation of** 10605377
10925529 **is a continuation in part of** 10709213
10936868 **is a continuation in part of** 10925529
11275693 **is a continuation of** 10604370
11276059 **is a continuation of** 10604370

Terminal Disclaimer

Enclosed with this Office action is a sample terminal disclaimer which is effective to overcome an obviousness-type double patenting rejection over a prior patent (37 CFR 1.1321(b) and (c)).

Also enclosed is a sample Statement Under 37 CFR 3.73(b) (Form PTO/SB/96) which an assignee may use in order to ensure compliance with the rule. Part A of the Statement is used when there is a single assignment from the inventor(s). Part B of the Statement is used when there is a chain of title. The "Copies of assignments..." box should be checked when the assignment document(s) (set forth in part A or part B) is/are not recorded in the Office, and a copy of the assignment document(s) is/are attached. When the "Copies of assignments..." box is checked, either the part A box or the part B box, as appropriate, must be checked, and the "Reel_____, Frame_____" entries should be left blank. If the part B box is checked, and copies of assignments are

not included, the "From:_____ To:_____" blank(s) must be filled in. This statement should be used the first time an assignee seeks to take action in an application under 37 CFR 3.73(b), e.g., when signing a terminal disclaimer or a power of attorney.

Claim Objections

Claims 1, 20, 41 and 52 objected to because of the following informalities: In line 3 of each of these claims, the term --a-- should be inserted between "having" and "striking". Appropriate correction is required.

Comments on IDS

With respect to the IDS, received 04/23/2004, the relevance of the citation to Wallace (U.S. Patent No. 6,310,185) is not understood. The reference is drawn to recombinant human anti-Lewis Y antibodies. Clarification is requested.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 571-272-4413. The examiner can normally be reached on Monday through Friday (6:30AM - 3:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene L. Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

S.Passaniti/sp
March 5, 2006

Sebastiano Passaniti
Primary Examiner